

REMARKS

Claim Rejections – 35 U.S.C. §103

The Office Action has continued to rely on (1) Smith, et al. (U.S. 5, 447, 462) (“Smith”) and (2) Battreall (U.S. 5, 234,523) (“Battreall”) for finally rejecting all pending claims under 35 U.S.C. §103(a). In particular, the Office Action rejected claims 1-7, 10-12, 27, and 33-34 as being unpatentable over Smith in view of Battreall. Applicant respectfully disagrees with the rejections.

The Office Action is in agreement with the applicants that the language in the preamble describing method steps is not being treated as a limitation in the pending claims.

Maintaining the rejections by the Office Action is based on (1) reducing thickness of an adhesive over the thickness possible in accordance with the prior art, a teaching away from the claimed thickness, does not distinguish the claims from the prior art, *see, e.g.*, page 2 lines 6-7; (2) change in thickness of a laminated garment is not a useful property that is limited by technology (known at the time the invention was made), *ibid* at lines 13-15, despite (a) the self-evident truth of the assertion, and (b) an affidavit by the inventor with at least the ordinary skill in the art; and (3) all adhesives are equivalent, *ibid*, even if (a) the prior art discloses that this is not the case.

The Office Action treats US Patent No. 3,657,060 (“the Haigh reference”) as overcome by prior amendments and thus irrelevant for any other purpose. This presumption is not known to have any support in applicable laws, regulations and guidelines. It is respectfully requested that some guidance be provided for discounting Haigh as a reference in the absence of any swearing behind or similar process.

In view of the currently applicable procedures, Applicant is still treating Haigh’s disclosure as available prior art for what it discloses and teaches.

The case law teaches that each reference must be evaluated as a whole, i.e., disclosures in the reference that diverge from and teach away from the invention cannot be disregarded. “Not only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time--a technician without our knowledge of the solution.” *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985).

As to item (1) mentioned in the Office Action, the unexpected result due to the claimed range is in making the product itself because the Haigh reference, without any contradiction by other references, teaches that this is not the way to go.

Further, it is not clear what type of ‘routine experimentation’ is being assumed by the

Office Action, *see, e.g.*, page 2 lines 8-10 from the bottom in the Office Action, without reliance on impermissible hindsight for experiments with the claimed adhesive. In view of the relevance of the Haigh reference and Battreal's silence on the experimentation aspect (a theory the Office Action has refrained from elaborating on), the argument made by the Office Action is fatally flawed. Plainly, Battreal does not disclose discounting the Haigh reference. Further, the conclusion that thickness is a "result effective variable" is irrelevant to patentability without a disclosure of the basis, both legal and factual, for providing a nexus with patentability requirements in the prosecution of this application. Therefore, the conclusory nature of the argument advanced by the Office Action requires more detail to allow a response to be formulated. Applicant also notes that such detail, if known, should have been provided earlier. In view of this defect in the rejections it is respectfully requested that the **finality of the Office Action be withdrawn** and sufficient details be provided to allow applicant a fair opportunity to respond.

Turning to item (2), to the extent the desirability of reducing the thickness of laminated garments is not self evident, applicant attaches a document disclosing that others have recognized as a desirable a reduced weight or thickness of a laminate garment. *See, e.g.*, page 2, 3rd line from the bottom.

As to item (3), there is no substantive evidence in the record to support the Office Action's conclusion that all adhesives are the same. Further, the Haigh reference plainly disagrees with this mistaken notion advanced by the Office Action that all adhesives are the same. Applicant respectfully requests sufficient clarification to allow a response to be formulated if something different from the plainly erroneous notion that all adhesives are the same was meant by the Office Action. In view of this defect in the rejections it is respectfully requested that the **finality of the Office Action be withdrawn** to allow applicant an opportunity to respond

Because the above described premise lacks evidentiary support in the record, being a mere presumption, applicant respectfully renews a request for the legal and factual basis for the rejections. Further, the selective picking of references, *e.g.*, only portions of the Haigh reference cited previously are considered to be relevant, and their contents is not in agreement with the MPEP directive to read references as a whole. In the absence of supporting evidence requested herein, the rejections must be withdrawn. Further, the presumptions conflict with the disclosure of at least the Haigh reference as discussed herein.

It is respectfully submitted that the present application is in condition for allowance because the Office Action has yet to provide details required to support its arguments.

Therefore, it is respectfully requested that either the finality of the Office Action be withdrawn to allow applicant an opportunity to respond to sufficiently reasoned rejections, or the application be allowed to proceed to allowance.

Although no fees are estimated to be due with this response, please charge any required fees to Jones Day Deposit Account No. 50-3013. Please do not hesitate in calling the undersigned with any suggestions for placing the application in order for allowance or if there is a need for clarifications.

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Respectfully submitted,



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